

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA

RICHTEK TECHNOLOGY  
CORPORATION,

Plaintiff,

v.

uPI SEMICONDUCTOR  
CORPORATION, MAXCHIP  
ELECTRONICS CORPORATION,  
POWERCHIP TECHNOLOGY  
CORPORATION, SILICON XTAL,  
AMANDA DAI, and JACKY LEE,

Defendants.

No. C 09-05659 WHA

**ORDER GRANTING IN PART  
AND DENYING  
IN PART MOTION  
TO AMEND INFRINGEMENT  
CONTENTIONS**

**INTRODUCTION**

In this patent infringement action, after a series of mandatory stays lasting seven years was finally lifted, plaintiff seeks leave to amend its infringement contentions. For the reasons stated below, plaintiff's motion is **GRANTED IN PART AND DENIED IN PART**.

**STATEMENT**

Plaintiff Richtek Technology Corporation owns U.S. Patent Nos. 7,315,190 ("the '190 patent"), 6,414,470 ("the '470 patent"), and 7,132,717 ("the '717 patent"), which cover technologies used in direct-current-to-direct-current (DC-DC) power controllers. It alleges that defendant uPI Semiconductor Corporation sells power management products that incorporate Richtek's proprietary and patented technologies, and that the remaining defendants also infringe

1 Richtek's patents by manufacturing, importing, selling, and marketing uPI's infringing  
2 products.

3 Richtek commenced this action in December 2009. In January 2010, an order stayed the  
4 case pending final determination in an investigation by the International Trade Commission  
5 (Dkt. No. 26). The ITC terminated its investigation after uPI entered a consent order and an  
6 order lifted the stay in October 2010 (Dkt. No. 89). Richtek served its initial infringement  
7 contentions pursuant to Patent Local Rule 3-1 in November 2010. In January 2011, an order  
8 suspended all motion practice and allowed discovery regarding whether the Court could  
9 exercise personal jurisdiction over defendant Powerchip Technology Corporation.

10 Because the allegations in Richtek's complaint broadly referred to the accused products  
11 as "power-management products," Richtek was ordered in January 2011 to "file papers  
12 identifying the specific chips or devices it contend[ed] infringe[d] the patents in suit. If Richtek  
13 already has specifically identified the accused products via infringement contentions, then  
14 Richtek may file and rest on its contentions" (Dkt. No. 235). Richtek filed and served *amended*  
15 infringement contentions (its first such amendment), accusing twenty-nine products that had not  
16 been identified in its initial infringement contentions. Richtek did not specifically seek leave to  
17 amend its initial infringement contentions.

18 In February 2011, Richtek filed a discovery letter because defendants refused to produce  
19 documents concerning the twenty-nine new products identified in its first amended infringement  
20 contentions (Dkt. No. 266). That letter indicated that defendants refused such production  
21 because Richtek had not sought leave to file its first amended infringement contentions. That  
22 discovery dispute was never resolved because the case was stayed the next day due to Richtek's  
23 commencement of an action before the ITC alleging that uPI had violated its consent order. An  
24 order stayed this action pending the resolution of the ITC proceedings. An order lifted the stay  
25 in January 2016 (Dkt. No. 443).

26 The parties appeared for a case management conference in February. The parties' joint  
27 case management statement omitted any reference to the February 2011 letter concerning  
28

1 Richtek's first amended infringement contentions, although it detailed the history of motion  
2 practice in the case.

3 Richtek now seeks leave to file its second amended infringement contentions to drop all  
4 claims for infringement against defendants that have been dismissed and to add three uPI  
5 products that Richtek did not learn about until after it served its first amended infringement  
6 contentions in January 2011 (and while the merits of the case were stayed). The new accused  
7 products were not developed or released until after the complaint was filed herein. uPI opposed  
8 Richtek's motion and the other defendants filed a separate notice joining in the opposition. This  
9 order follows full briefing and oral argument.\*

### 10 ANALYSIS

11 Rule 15(d) of the Federal Rules of Civil Procedure provides that a supplemental  
12 pleading, not merely an amended pleading, is necessary to set forth "any transaction,  
13 occurrence, or event that happened after the date of the pleading to be supplemented." Thus,  
14 the filing of a complaint sets the cut-off date for the scope of a case, subject to the possibility of  
15 supplementation. Nevertheless, for some time, patent owners have made open-ended  
16 allegations in their complaint that do not specifically identify the accused products and used  
17 amendments to their infringement contentions to expand the scope of the case to encompass  
18 products developed or released after the date of the complaint without the need to file a  
19 supplemental complaint — essentially sneaking new products into the case through the back  
20 door of infringement contentions. The result of this development is that patent infringement  
21 actions often expand to the point of unmanageability.

22 On December 1, 2015, the amended Federal Rules of Civil Procedure took effect. The  
23 amended Rules apply to pending cases "insofar as just and practicable." H.R. Doc. No. 114-33,  
24 at 2 (2015). The changes included the deletion of Rule 84, which provided, "[t]he forms in the  
25 Appendix suffice under these rules and illustrate the simplicity and brevity that these rules  
26 contemplate." The Appendix referenced in Rule 84 included Form 18, an example complaint

---

27  
28 \* After this motion was fully briefed, defendants moved to amend their invalidity contentions to  
include newly-discovered prior art references.

1 for patent infringement. Form 18 merely included an allegation that the defendant infringed the  
2 asserted patent by making, using, or selling “electric motors” without specifying the model of  
3 the accused motors. The Federal Circuit held that, pursuant to Rule 84, the pleading standard  
4 set forth in Form 18, not the pleading standard in *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544  
5 (2007), controls. *In re Bill of Lading*, 681 F.3d 1323, 1334 (Fed. Cir. 2012). Rule 84 has been  
6 abrogated, so *In re Bill of Lading* no longer applies.

7 Patent Local Rule 3-1(b) requires patent owners to identify each accused product of  
8 which the patent owner is aware by serving infringement contentions on the accused infringer  
9 “not later than 14 days after the Initial Case Management Conference.” Patent Local Rule 3-6  
10 provides that a party may amend its infringement contentions “only by order of the Court upon  
11 a timely showing of good cause.” Richtek contends that it should be granted leave to file its  
12 second amended infringement contentions to include new products released since it served its  
13 first amended infringement contentions in 2011 because it acted diligently and because  
14 defendants would suffer no undue prejudice. For their part, defendants respond that Richtek  
15 should have brought this motion 14 days after the case management conference in January  
16 (after the stay was lifted). Richtek’s request to add new products, however, does not merely  
17 seek an amendment. Rather, it seeks to supplement the operative pleadings. Richtek has failed  
18 to request to *supplement* its first amended infringement contentions or its complaint.

19 In the only decision to address the propriety of the addition of new products to a case  
20 through amendments to infringement contentions following the abrogation of Rule 84, the  
21 undersigned judge held that “[t]here must be some reasonable cut-off date after which [the  
22 patent owner] cannot further expand the case simply because [the accused infringer’s] product  
23 cycle has outpaced the resolution of this case,” and denied the patent owner’s motion seeking  
24 leave to amend its infringement contentions to add new products seven months before trial.  
25 *Rembrandt Patent Innovations LLC v. Apple Inc.*, No. 14-5094, 2015 WL 8607390, at \*3 (N.D.  
26 Cal. Dec. 13, 2015). There, as here, the patent owner failed to recognize that the addition of  
27 new products required a supplemental pleading, not merely an amendment.  
28

1 Here, our problem is not the rapid pace of the accused infringer's product development  
2 (as it was in *Rembrandt*), but rather the sluggish pace of this litigation due to a series of  
3 mandatory stays pending the resolution of proceedings at the ITC. Now that the case here is  
4 back on track and with trial scheduled in December, it is time for the case to narrow, not  
5 expand. Accordingly, Richtek may not add new products to this case, although it remains free  
6 to pursue claims based on those products (and any others it uncovers in discovery) in a  
7 subsequent proceeding.

8 Defendants also contend that Richtek's failure to seek leave to file its first amended  
9 infringement contentions way back in 2011, also precludes it from asserting claims based on the  
10 twenty-nine products it added to the case with that amendment. Richtek should have sought  
11 leave to add new products to the case (indeed, such a request may have been denied at the time);  
12 and its February 2011 letter seeking discovery relief regarding those products demonstrates that  
13 there was at least some disagreement among the parties as to which were the operative  
14 infringement contentions. Nevertheless, defendants failed to raise this issue in the joint case  
15 management statement or at the case management conference after the stay was lifted in  
16 January 2016, and they declined to move to strike Richtek's first amended infringement  
17 contentions, waiting instead to raise the issue in their opposition to this motion more than two  
18 months after the stay was lifted. Defendants do not offer any indication that they will be  
19 unfairly prejudiced by the inclusion of the twenty-nine products in Richtek's first amended  
20 infringement contentions. Rather, it appears that defendants are simply latching on to an  
21 opportunity to obstruct the progress of this case. Although, as stated, Richtek's motion is  
22 denied to the extent it seeks to add three new products, this order holds that the case will  
23 include all products identified in Richtek's first amended infringement contentions (including  
24 the twenty-nine additional products accused therein).


25 Finally, Richtek has plainly showed good cause to remove contentions relating to parties  
26 that have been dismissed from the action (a motion that would not require supplementation).  
27 To that extent only, Richtek's motion to file its second amended infringement contentions is  
28 **GRANTED.**

**CONCLUSION**

For the reasons stated above, plaintiff's motion for leave to file its second amended infringement contentions **GRANTED IN PART AND DENIED IN PART**. Plaintiff may remove claims against parties that have been dismissed. All products identified in the first amended infringement contentions remain in the case, but the new products identified in the proposed second amended infringement contentions may not be included.

**IT IS SO ORDERED.**

Dated: April 29, 2016.

  
\_\_\_\_\_  
WILLIAM ALSUP  
UNITED STATES DISTRICT JUDGE